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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kimmo Laiho

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EXAMINER

DANG, KHANH

ART UNIT

PAPER NUMBER

2111

MAIL DATE

DELIVERY MODE

06/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/531,104

Applicant(s)

LAIHO, KIMMO

Examiner

Khanh Dang

Art Unit

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 5, 7-10, 12-14 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7-10, 12-14, 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claim 7 and newly added claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 is directed to an apparatus. However, the essential structural cooperative relationship(s) between the so-called "means for detecting the presence of a host"" and other recited elements in the claim have been omitted, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

MPEP 2172.01 requires that relationships between elements recited in the claims must be specified. Specifically, MPEP 2172.02 requires interrelation and structural relationships between essential elements in the claims. Therefore, it is the Examiner's position that the claimed elements, as defined in the originally filed specification and as identified above, are essential elements to the claimed invention. Since they are essential elements as defined in the originally filed specification, their structural cooperative relationships must be provided in the claims. Further, it is also the Examiner's position that the claimed elements, as identified above, function simultaneously, are directly functionally related, directly inter-cooperate, and/or serve independent purposes, as evidenced from the originally filed specification.

If Applicants disagree with the Examiner that the above identified elements, as defined by the originally filed specification, are essential elements to the claimed

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invention, and that the above identified elements are directly functionally related, directly inter-cooperate, and/or serve independent purposes, it is requested that Applicants provide evidences showing that the identified elements are not essential elements to the claimed invention, do not function simultaneously, are not directly functionally related, do not directly inter-cooperate, and/or do not serve independent purposes; and state on the record that this is the case.

In claim 7, the language "the device is arranged for causing at least some lines of the host module to be forced tri-state in response to the detecting the presence of the host externally connected to the bus" cannot be ascertained in view of the specification ([0028]).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

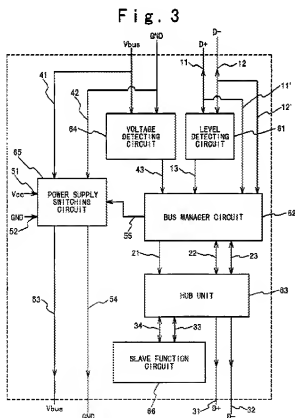
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 5, 7-10, 14, and 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Oguma (6516205, cited by Applicants).

As broadly drafted, claims 1-11 and 14-19 do not define any structure/step that differs from Oguma.

The rejection outlined in a previous Office Action is reproduced below. New limitations added to the claims by the 4/24/2008 amendment, is fully addressed below under "Response to Argument."

With regard to claim 1, Oguma discloses a device operable as a host device (as shown generally in Fig. 3, which is reproduced below for ease of convenience and reference, the portable device comprises a bus manager circuit can be operable as a host device)



comprising: a port connected to a bus (as shown in Fig. 3, USB port of the portable device provides connection to the USB bus comprising Vbus, GND), means for detecting the presence of another host connected to the bus and for relinquishing host status in response thereto (the voltage detecting circuit 64 is readable as the so-called "means for detecting." When the detecting circuit 64 detects presence of another host 1 connected to the USB bus, the host status of the portable device is relinquished. See at least column 2, lines 39-57, column 4, line 65 to column 6, line 17).

With regard to claim 2, the host provides power supply for providing a supply voltage on a voltage supply line (Vbus GND) of the bus.

With regard to claim 4, it is clear from discussion above that the voltage detecting circuit detects a change in voltage on a voltage supply line of the bus, thereby detecting the presence of the other host. See at least column 2, lines 39-57, column 4, line 65 to column 6, line 17).

With regard to claim 5, it is clear from discussion above that the change is an increase.

With regard to claim 7, as best the Examiner can ascertain from the language of the claim, in Oguma, the portable device is arranged for causing at least some lines Vbus GND, D lines of the port to be forced tri-state such as suspended, active, and unavailable states, on detecting the presence of another host.

With regard to claim 8, according to USB standard, upon discover a connected host, a reset signal is sent to a USB slave.

With regard to claim 9, see discussion above and at least column 2, lines 39-57, column 4, line 65 to column 6, line 17.

With regard to claim 10, see discussion above regarding claims 1 and 6 and at least column 2, lines 39-57, column 4, line 65 to column 6, line 17.

With regard to claim 14, see discussion above regarding claim 1.

With regard to claim 17, see discussion above.

With regard to claim 18, it is clear that a USB slave can be connected to the portable device. See at least Fig. 1.

With regard to claims 19-21, see discussion above regarding claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oguma.

As discussed above, Oguma discloses the claimed invention except for the inclusion of the bus manager circuit responsible for providing a host status to the portable device, to a battery pack for providing power supply to the portable device 5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the bus manager responsible for providing the host status to the portable device, to the battery pack of the portable device, since the battery pack is always an integral part of the portable device as evidenced by at least Chandley (7,349,689), and further moving the manager circuit to the battery pack only involves ordinary skill in the art.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oguma.

As discussed above, Oguma discloses the claimed invention including the use of a portable device such as a portable phone.

However, Oguma does not disclose that the portable device is capable of receiving video broadcast.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the portable device with capability of receiving video broadcast, since providing a portable device such as a portable or mobile phone with a

capability of receiving video broadcast is old and well-known and only involves ordinary skill in the art as evidenced by at least Chandley (7,349,689). As a matter of fact, every smart phone is able to connect to the internet for downloading audio and video contents.

Response to Arguments

Applicants' arguments filed 4/24/2008 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). As a matter of fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.*, 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.

The 112 Rejection:

See discussion above.

The 102 Rejection:

With regard to claims 1, 17, and 19, Applicants have argued that “Amended independent claim 1 recites, among other features, ‘a device operable as a host device, the device including: a bus; a first port, the first port being connected directly to the bus; a second port, the second port being connected directly to the bus.’ Oguma fails to teach or suggest the recited features. Instead, Oguma at col. 4, lines 9-28 and Figure 3 describes a portable phone 5 that determines whether a host personal computer 1 is connected and operating as a bus manager; when the host personal computer 1 is connected and operating as a bus manager, a bus manager circuit 62 in portable phone 5 stops or invalidates a bus manager function and passes signals between the host personal computer 1 and bus peripheral units. Conversely, when the host personal computer 1 is not connected, or when the host personal computer 1 is in a suspended state, bus manager circuit 62 sends a power selection signal 55 to a power supply switching circuit, which serves to supply power to an external device connected to portable phone 5 on a downstream side via an internal power source of portable phone 5. See Oguma at col. 4, lines 9-50 and Figure 3. The portable phone 5 described in Oguma does not include a bus as required by amended claim 1. See Oguma at Figure 3. As such, claim 1 is allowable for at least this reason. Oguma at col. 3, lines 48-65, col. 4, lines 9-50 and Figure 3 describes portable phone 5 as including

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upstream lines D+ 11, D- 12, Vbus 41 and GND 42 and downstream lines D+ 31, D- 32, Vbus 53, and GND 54. Even assuming (without admitting) that the upstream lines could appropriately be analogized to one of the recited first and second ports and the downstream lines could appropriately be analogized to the other of the recited first and second ports, Oguma fails to disclose the upstream lines being directly connected to a bus and the downstream lines being directly connected to the same bus as required by claim 1. As such, since Oguma fails to disclose all of the features recited in claim 1, claim 1 is allowable for at least these additional reasons. Furthermore, amended claim 1 recites, among other features, 'a host module, the host module being connected directly to the bus.' Even assuming (without admitting) that the bus manager circuit 62 disclosed in Oguma at Figure 3 can appropriately be analogized to the recited host module, bus manager circuit 62 is not directly connected to a bus, much less the same bus that each of the first and second ports are connected to as required by claim 1."

In response to Applicants' argument, at the outset, Applicants' Fig. 3 is reproduced below for comparison.

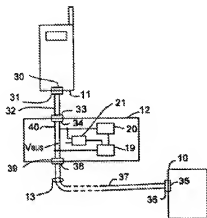


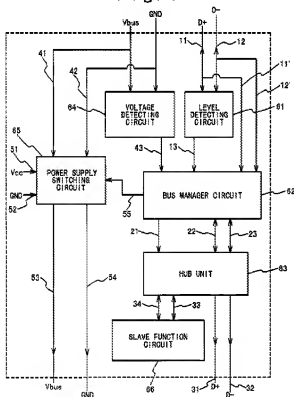
Figure 3

Thus, contrary to Applicants' argument, Fig. 3 of Oguma, which is reproduced below for ease of reference and comparison, shows the so-called "device operable as a host." Further as shown in Fig. 3, the device includes a USB bus comprising Vbus, GND, D+, and D-. The device further comprises a first upstream port connected directly to the USB bus; and a second downstream port connected directly to the same USB bus running from the first upstream USB port to the second downstream USB port. The device as shown in Fig. 3 of Oguma also shows the so-called "host module" or bus manager circuit 62 connected directly to the same USB bus; and the "comparator" or voltage circuit 64 detecting coupled to the same USB bus to detect the presence of a

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host externally connected to the USB bus. A voltage detecting circuit basically comprises a voltage comparator for comprising a supply voltage with a reference voltage (VREF) to detect a change in voltage or a difference between supply voltage and reference voltage. Further, as noted above, a USB bus comprises Vbus, GND, D+, and D-. It is also important to note that Applicants' Fig. 3 shows a Vbus line, and other lines are grouped together as line 40.

Fig. 3



The 103 Rejection:

With regard to claims 12 and 13, Applicants have argued that "Claims 12 and 13 each depend from claim 1, and are allowable for at least the same reasons as claim 1. Moreover, the Office Action at pages 8-9 correctly indicates that Oguma fails to disclose the features recited in each of claims 12 and 13. The Office attempts to remedy the acknowledged deficiencies of Oguma by asserting that it would have been obvious to incorporate the features recited in each of claims 12 and 13. Applicant respectfully requests the Office to provide proof/documentation that demonstrates why it would have been obvious for a skilled artisan to incorporate the recited features into Oguma at the time of the instant invention/application. Pending such proof/documentation, Applicant respectfully submits that claims 12 and 13 are further allowable in view of the advantageous features recited therein."

In response to Applicants' request for evidence to support the Examiner position that it is well-known for a portable device such as a portable phone to include a battery and to be capable of receiving video broadcast, US Patent No. 7349689 to Chandley is hereby cited for support.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dang whose telephone number is 571-272-3626.

The examiner can normally be reached on Monday-Friday from 9:AM to 5:PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on 571-272-3632. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Khanh Dang/

Primary Examiner, Art Unit 2111